UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte PHILIP C. COMP

Appeal No. 2004-2224
Application No. 08/323,060

ON BRIEF

Before WILLIAM F. SMITH, SCHEINER, and ADAMS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-6, 11-13 and 19. According to the examiner (Answer, page 2), the only other claims pending in this application, claims 7-9, 20 and 21, are allowable.

Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A method for inhibiting microvascular bleeding at a site in a patient exhibiting microvascular bleeding comprising administering to the patient a compound in a pharmaceutically acceptable carrier in an effective amount to prevent anticoagulation by greater than 90% of activated protein C in human plasma, wherein the compound is an inhibitor of an anticoagulant selected from the group consisting of protein C, antithrombin III, heparin cofactor II, thrombomodulin and tissue factor pathway inhibitor.

No prior art is relied upon by the examiner.

GROUND OF REJECTION

Claims 1-6, 11-13 and 19 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on specification that fails to adequately describe the claimed invention.

We affirm.

CLAIM GROUPING

According to appellant (Brief, page 4), "[c]laims 1-6, 11-[1]3, and 19 stand or fall together...." Since all claims stand or fall together, we limit our discussion to representative independent claim 1. Claims 2-6, 11-13 and 19 will stand or fall together with claim 1. In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

DISCUSSION

The examiner finds (Answer, page 4), appellant's "specification does not convey to the artisan that the applicant had possession at the time of [the] invention of ... [an] 'inhibitor of an anticoagulant' as recited in the claims." According to the examiner (id.), "[t]he claims encompass a vast genus of potential agents which could function as an 'inhibitor of an anticoagulant' ... while only disclosing antibodies which have that function."

In response appellant asserts (Brief, page 9), the specification "states that other types of inhibitors can be used (bottom of page 12 to top of page 13)." For clarity the paragraph bridging pages 12-13 of the specification is reproduced below:

> Other compounds that may be effective include compounds which inhibit Protein S, thereby inhibiting activated protein C. Other agents include those which inhibit thrombomodulin, antithronbin III, heparin cofactor II, and tissue factor inhibitor pathway. Examples of such compounds include antibodies against Protein s, thrombomodulin, antithrombin III, heparin cofactor II, and tissue factor inhibitors), as well as specific chemical inhibitors. Specific chemical inhibitors of activated protein can also be used.

However, the examiner finds (Answer, page 8), this portion of appellant's specification "refers to undisclosed chemical inhibitors without identifying said agents." A written description of an invention involving a chemical genus, like a description of a chemical species, 'requires a precise definition, such as by structure, formula, [or] chemical name,' of the claimed subject matter sufficient to distinguish it from other materials." University of California v. Eli Lilly and Co., 119 F.3d 1559, 1567, 43 USPQ2d 1398, 1405 (Fed. Cir. 1997). While the subject matter in Lilly was directed to genetic material, the requirement of the statute applies to all types of invention. See University of Rochester v. G.D. Searle & Co., Inc., 358 F.3d 916, 925, 69 USPQ2d 1886, 1893 (Fed. Cir. 2004) ("Regardless whether a compound is claimed per se or a method is claimed that entails the use of the compound, the inventor cannot lay claim to that subject matter unless he can provide a description of the compound sufficient to

distinguish infringing compounds from non-infringing compounds, or infringing methods from non-infringing methods.").

In addition, appellant directs our attention to several journal references that allegedly demonstrate that inhibitors of anticoagulants were known in the art as of the filing date of the application. See Brief, bridging paragraph, pages 9-10. However, as the examiner points out (Answer, page 6, emphasis removed), a number of these references were published after the July 24, 1992 effective filing date of the instant application.[1] Whether or not an application adequately describes a claimed invention is determined as of the application's filing date. See Hyatt v. Boone, 146 F.3d 1348, 1354, 47 USPQ2d 1128, 1132 (Fed. Cir. 1998) ("[T]he purpose of the description requirement is 'to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.'").

Post-filing date references may be cited for limited purposes; e.g., as evidence of the state of the art as of the relevant date. See, e.g., In re Hogan, 559 F.2d 595, 605, 194 USPQ 527, 537 (CCPA 1977) ("[U]se of later publications as evidence of the state of art existing on the filing date of an application" is acceptable; emphasis in original). However, an applicant cannot rely on post-filing advances in the art to supplement a disclosure that was

[1] The instant application was a File Wrapper Continuation of Application No. 07/919,219 (the subject matter of prior Appeal No. 1999-2254), filed July 24, 1992.

inadequate at the time it was filed. See In re Glass, 492 F.2d 1228, 1232, 181 USPQ 31, 34 (CCPA 1974):

> [A]pplication sufficiency under § 112, first paragraph, must be judged as of its filing date. It is an applicant's obligation to supply enabling disclosure without reliance on what others may publish after he has filed an application on what is supposed to be a completed invention. If he cannot supply enabling information, he is not yet in a position to file.

(Emphasis in original). What the Glass court held with respect to enablement applies equally to written description. The post-filing date references cited on pages 9-10 of appellant's Brief cannot be relied on to show appellant's possession, in 1992, of the genus of anticoagulant inhibitors now claimed.

With regard to the references relied upon by appellant which published prior to appellant's effective filing date, we note that according to the examiner (Answer, page 8),

> even if all of the references cited [o]n pages 9-10 of the Brief were considered, all but one of said references are drawn to [the] use of antibodies against the inhibitors recited in the claims. ... The single non-antibody reference is the Gene 1993 publication[,] which does not describe an inhibitor of an anticoagulant. It describes an inhibitor of a coagulant, not an anticoagulant. The specification does not disclose said publication or use of the methods of said publication to produce an inhibitor of an anticoagulant. Thus, appellant has not disclosed a single example of an art known inhibitor of an anticoagulant other than an antibody.

For the foregoing reasons we affirm the rejection of claim 1 under 35 U.S.C. § 112, first paragraph. As discussed supra claims 2-6, 11-13 and 19 fall together with claim 1.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

William F. Smith
Administrative Patent Judge

Toni R. Scheiner
Administrative Patent Judge

Donald E. Adams
Administrative Patent Judge

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